

REMARKS

Claims 8-12, as amended, and 16-29, as amended are pending in this application for the Examiner's review and reconsideration.

Claim 8 was amended to more clearly recite that the cassette has means thereon for attaching the cassette to an identically shaped cassette. -Claims 9-12, 16-18 were amended to clarify that the "case" referred to the "cassette." Claim 16 et seq. were amended, replacing the term "case" with "cassette housing," again to clarify that the "case" was part of the cassette housing. These amendments are not believed to add new matter nor require additional searches. As was clearly stated in the amendment dated January 8, 2004, in the first REMARKS page, sixth paragraph, second and third line: "Claim 8 is directed to a cassette comprising a supply of image receiving tape and a case. The case is a housing for the cassette." No new matter has been added by these amendments, and these amendments clarify the issues for subsequent appeal, and their entry at this time is respectfully requested.

OBJECTIONS TO CLAIMS

Examiner objected to claims 12 and 25 because of formalities. Specifically, Examiner alleges that term "a second cassette" in claim 12 is inconsistent in terminology with "an identically shaped cassette" in claim 8. Applications have amended claims 12 and 25 to provide for consistent terminology. The Examiner objected to the phrase "The more than two cassettes" in claim 25 as lacking antecedent basis. The amendments to these claims are believed to make these objections moot, and are not believed to be for reasons of patentability.

REJECTION UNDER 35 U.S.C. § 102 (B)

The Examiner rejected claims 8-12 under 35 U.S.C. § 102 (b) as being anticipated by U.S. Patent No. 5, 547, 298 to Wouters *et al.* ("Wouters"). Specifically, the Examiner alleged that "Wouters *et al.* teach a cassette comprising supply (S_s) of image receiving tape (R) and a case (P) having means ...for attaching the case an identically shaped case." The Examiner further alleged that "image receiving tape does not distinguish from the ribbon tape of Wouters *et al.* as a thermal ribbon maintains an image on the ribbon due to the dye being transferred to a receiver." Consequentially, the Examiner alleges that the dye ribbon package for thermal printers disclosed in Wouters anticipates the tape holding cases of the instant application.

Applicants respectfully traverse. Applicants have previously stated that the “case” was a part of the cassette, *i.e.*, the case housing of the cassette. Wouters shows packages holding items, and the Examiner has equated the packages of Wouters to the cassettes of the instant claims. Claim 8, as previously on file and as presently amended, specifically recites that the means are provided for the purpose of attaching the cassette to an identically shaped cassette, not for attaching a case to an identically shaped case. Wouters teaches outer packages (cases) having means thereon to attach to other outer cases, but Wouters does not teach or suggest the cassette having means thereon for attaching the cassette to an identically shaped cassette. Consequently, Wouters cannot anticipate claim 8. Applicants have previously stated with respect to Wouters that the “case” that was in claim 8 was the housing for the cassette, *i.e.*, the case was a part of the cassette. Applicants have amended claim 8 to more clearly recite that the cassette has means thereon for attaching the cassette to an identically shaped cassette. This feature is not disclosed in Wouters. Wouters discloses a case (P) and a cassette (C). It is clear that it is the case (P) that is provided with means for attachment, and not the cassette (C). Claim 8 now makes it clear that it is the cassette itself, which is limited to having the feature of means for attaching the cassette to an identically shaped cassette. Independent claim 8 and consequently dependent claims 9-12 are therefore not anticipated by Wouters. For the above reasons, Applicants respectfully request that the rejection of claims 8-11 under 35 U.S.C. § 102 (b) be reconsidered and withdrawn.

REJECTION UNDER 35 U.S.C. § 103 (A)

The Examiner rejected claims 8-12, 16-18 and 21-26 under 35 U.S.C. § 103 (a) as being unpatentable over U.S. Patent No. 3,823,808 to Murata *et al.* (“Murata”) in view of U.S. Patent No. 3,687,036 to Herberger (“Herberger”). Specifically, the Examiner alleged that Murata “teach a cassette comprising an outer case (12), a supply of image receiving tape (25), pins (28, 29, 31, 32) for guiding the tape, and an outlet (not labeled) to allow the tape to exit the case.” Furthermore, the Examiner alleges that Murata teaches “means (43) for attaching the cassette to a tape printer.” Regarding the Herberger reference, the Examiner alleged that Herberger “teaches the desirability of utilizing a functional projection (29) on a case (1) to not only interact with the machine the case is inserted into but also to aid in the attaching, stacking, shipping, and storing of like cases.” Thus, the Examiner alleges, it would have been obvious to one of ordinary skill in the art to combine the teachings of the case in Murata with the with means, in form of a corresponding recess, in view of Herberger, so as to aid in storing and shipping of cassettes. In responding to the Applicant prior arguments, the Examiner further remarked that “[t]he projection of Murata et al.

inherently causes a problem of stacking and Herberger teaches the desirability of using such a projection to facilitate stacking.”

Applicants respectfully disagree. Herberger does not teach the desirability of utilizing a functional projection “to aid in the attaching, stacking, shipping, and storing of like cases.” Rather, Herberger addresses a problem with stacking which is presented by the provision of a functional projection. Herberger states that regarding prior art cartridges, “the absence of projections on the ends of these cartridges makes end-to-end stacking of the cartridges an uncomplicated matter.” See Herberger, column 1, lines 28-30. If the functional projection were not present, there would be no problem with the stacking of the cases in Herberger. The specific problem that Herberger addresses is that the functional projection creates problems in stacking the cases. As such, Herberger teaches the skilled person that projections on cases should be avoided where stacking of cases is desired. There is no suggestion in Herberger that the provision of a projection is advantageous in stacking. Rather, Herberger aims to circumvent the problems caused by the projection. Herberger teaches that a projection on a case is problematic, and not helpful, in respect of stacking of cases.

Similarly, Murata does not teach that its projection causes a problem of stacking. There is no such teaching whatsoever in Murata; Murata does not discuss stacking at all. The lozenge shape projection or retaining member 43 serves to force the tape cartridge 12 toward the thermal head 42 with a predetermined pressure once the cartridge has been inserted (see Murata, column 5, lines 57-61). There is no suggestion that there would be any difficulty in stacking the cassettes of Murata. Unlike the functional projections of Herberger’s photographic film cartridges, the projection on the cassettes of Murata is a small projection, relative to the size of the cassette itself. Even if one of ordinary skill in the art skilled were to consider stacking the cassettes of Murata, there is no indication given in the reference that there is any problem caused in the stacking of the tape cartridge by the functional projection. There is no teaching in Murata that stacking the cassettes would be problematical, and therefore no reason for one of skill in the art to search for solutions. There is certainly no indication that a problem would be caused such as the problem caused in Herberger. Thus, based on the disclosure of Murata, it cannot be assumed that the projections inherently cause a problem of stacking, and one of ordinary skill in the art would not look toward other art for solutions.

The motivation to combine must come from the references themselves, combined with the knowledge of one of ordinary skill in the art. Since Murata does not suggest that projections cause a problem of stacking, since any stacking problem with the cases having projections of Murata are not apparent, there is no motivation to combine the Murata and Herberger reference. *See M.P.E.P. § 2143.01* (the prior art must suggest the desirability of the claimed invention). There is no teaching in either document that would lead a person of ordinary skill in the art to the other document. For the above reasons, Applicants respectfully request that the rejection of claims 8-12, 16-18 and 21-26 under 35 U.S.C. § 103 (a), be reconsidered and withdrawn.

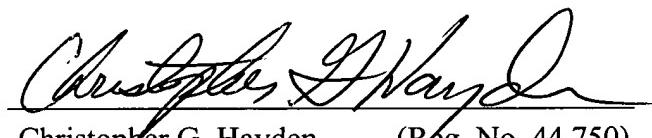
CONCLUSIONS

It is respectfully submitted that all claims are now in condition for allowance, early notice of which would be appreciated. Should the Examiner disagree, Applicants respectfully request a telephonic or in-person interview with the undersigned attorney to discuss any remaining issues and to expedite the eventual allowance of the claims.

No fees are believed to be required for this submission. Should any fees be required, however, please charge those fees to Morgan, Lewis & Bockius LLP deposit account no. 50-0310.

Respectfully submitted,

Date: May 18, 2004


Christopher G. Hayden (Reg. No. 44,750)
MORGAN, LEWIS & BOCKIUS LLP
1111 Pennsylvania Avenue, N.W.
Washington, D.C. 20004

(202) 739-3000-p
(202) 739-3001-f

Customer No.: 009629